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TO:	Examiner David Armand Wiley	FROM:	Benjamin S. Withrow, Esq.
COMPANY:	USPTO - Art Unit 2143	DATE:	11-28-05
FAX NUMBER:	571-273-8300	TOTAL NO. OF PAGES INCLUDING COVER:	25
PHONE NUMBER:		SENDER'S REFERENCE NUMBER:	7000-091
RE:	Appeal Brief	YOUR REFERENCE NUMBER:	09/973,412

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## NOTES/COMMENTS:

Please find attached the following item(s):

- 1) Appeal Brief (23 pages) and
- 2) Credit Card Payment Form (1 page).

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Paul T. Brescia

Examiner: Bengzon, Greg

Serial No. 09/973,412

Art Unit: 2144

Filed: 10/09/2001

For: **LOCATION-BASED ADDRESS PROVISION**

Mail Stop Appeal Brief – Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

An **APPEAL BRIEF** is filed herewith pursuant to 37 C.F.R. § 41.37. Appellant also encloses a credit card form authorizing payment in the amount of \$500.00 as required by 37 C.F.R. § 1.17(c). If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

**APPEAL BRIEF****(1) REAL PARTY IN INTEREST**

The present application is owned by Nortel Networks Limited of 2351 Boulevard Alfred-Nobel, St. Laurent, Quebec, Canada H4S 2A9, which is wholly owned by Nortel Networks Corporation, a Canadian corporation.

**(2) RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences to the best of Appellant's knowledge.

**(3) STATUS OF CLAIMS**

Claims 1-38 are canceled.

Claims 39-54 are pending with a final rejection made April 26, 2005.

Claims 39-54 are the subject of the current appeal.

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**(4) STATUS OF AMENDMENTS**

Appellant made a minor amendment to claim 47 in the Response filed June 20, 2005. The Advisory Action, mailed July 6, 2005, indicates that this amendment will be entered. Thus, to the best of Appellant's knowledge, all amendments have been entered.

**(5) SUMMARY OF CLAIMED SUBJECT MATTER**

Claims 39 and 47 are essentially identical independent claims, albeit in method and apparatus form. Claim 39 is directed to providing content to a mobile terminal user based on the location of the mobile terminal. The mobile terminal may be a portable computer 20, a personal digital assistant 22, a mobile telephone 24, or the like. Content is created for different geographic locations. Different content is then provided on different servers, each with its own unique internet protocol address. An explanation of the servers 16 that host the content and the addresses is also found in paragraph 0019. These unique internet protocol addresses are specifically associated with the different geographic locations based on the location specific content (see paragraphs 0026 and 0027). The current location of the mobile terminal is determined (see paragraphs 0024 and 0025). The current location may be in any one of the different geographic locations for which content has been created. Based on the location of the mobile terminal, an appropriate address is identified, and the address is delivered to the mobile terminal (paragraph 0039). The mobile terminal may selectively access content associated with the address after deliver (paragraph 0040).

Claim 47 is, as noted, substantially similar, but in apparatus form and including a network interface 48 and a control system 42 (see Figure 2).

**(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

A) Whether claims 39 and 47 are properly rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

B) Whether claims 39-43, 46-51, and 54 are properly rejected under 35 U.S.C. § 103 as being unpatentable over Owensby in view of Heddaya et al.

C) Whether claims 44, 45, 52, and 53 are properly rejected under 35 U.S.C. § 103 as being unpatentable over Owensby in view of Heddaya et al., further in view of Guedalia.

**(7) ARGUMENT****A. Introduction**

The various rejections set forth by the Patent Office are improper. The first rejection that the claims are indefinite is improper because, while the claim language is broad, the claim language is definite when considered in the context of the specification. More breadth is insufficient to make a claim indefinite. The rejections based on the references are improper because the combinations are not compelled by the motivations set forth by the Patent Office. Even if the combinations are proper, the combinations do not establish *prima facie* obviousness. Since the rejections are improper, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

**B. Summary of the References****1. U.S. Patent No. 6,647,257 to Owensby**

U.S. Patent No. 6,647,257 to Owensby discloses a system that inserts advertisements into wireless communication flows. The messages are targeted based on the location of the mobile terminal at the time of the wireless mobile communication, demographics of the area, and personal preference data (see abstract). The mobile terminal may include a wireless internet service (col. 11, lines 59-65). The system includes a subscriber support module 31 that receives inquiries, responses, and requests from the subscriber (col. 22, lines 35-40). The primary purpose of the subscriber support module 31 is to insert targeted advertisements into communication flows so that the subscriber receives the targeted advertisement. If the subscriber makes a request, the information provided in response may vary based on the location of the subscriber (col. 22, lines 48-51). Alternatively, a customer service representative may provide the information to the subscriber without the subscriber making a request.

**2. U.S. Patent No. 6,622,157 to Heddaya et al.**

U.S. Patent No. 6,622,157 to Heddaya et al. (hereinafter "Heddaya") discloses, in its background, a news service organization that has a home server based in a first location (a domestic site) and overseas sites that mirror the domestic site (col. 2, lines 43-61). Thus, when a request from an overseas client is made to the domestic site, the overseas site may provide the response to the request (col. 2, lines 43-61). An alternate background system includes offloading work from a home server to an intermediate server interconnected to the home server and the

client. If a document must be customized, the work of customization is done by the intermediate server rather than the home server (col. 3, lines 25-40).

### 3. U.S. Patent No. 6,480,711 to Guedalia

U.S. Patent No. 6,480,711 to Guedalia discloses a system wherein the user has preprogrammed message requests for specific data to be transmitted according to a specific schedule (col. 7, lines 57-59). The user provides the activation criteria for transmitting the data (col. 7, lines 60-62). The activation criteria can be time-based, event-based, or a combination of both (col. 7, line 66-col. 8, line 1).

#### C. Legal Standards

##### 1. 35 U.S.C. § 112, Second Paragraph

The Patent Act reads as follows: “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, second paragraph. Thus, the second paragraph has two distinct requirements. The first requirement is that the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the Patent. The second requirement is that the claims must set forth the subject matter that Appellant regards as the invention. MPEP § 2171.

The first requirement that the claims must particularly point out and distinctly claim the invention is an objective requirement. The purpose of this requirement is to ensure that the scope of the claims is clear. The focus is on whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. All that is required is a reasonable degree of particularity and distinctness. “Some latitude in the manner of expression and the aptness of term should be permitted even though the claim language is not as precise as the examiner might desire.” MPEP § 2173.02. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: the content of the particular application disclosure; the teachings of the prior art; and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.*

The second requirement supports a rejection only when the Appellant states, somewhere other than the application as filed, that the invention is something different than what is defined by the claims. MPEP § 2172.

## 2. 35 U.S.C. § 103

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Courts have interpreted 35 U.S.C. § 103(a) as a question of law based on underlying facts. As the Federal Circuit stated:

Obviousness is ultimately a determination of law based on underlying determinations of fact. These underlying factual determinations include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness.

*Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998) (internal citations omitted).

Once the scope of the prior art is ascertained, the content of the prior art must be properly combined. Initially, the Patent Office must show that there is a suggestion to combine the references. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). To show that there is a suggestion to combine the references, the Patent Office must first state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *Id.* While there are myriad sources available to show the motivation to combine the references, the range of available sources does not diminish the requirement for actual evidence. *Id.* If a proposed combination would render the reference being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed combination. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

After the combination has been made, for a *prima facie* case of obviousness, the combination must still teach or fairly suggest all of the claim elements. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974); MPEP § 2143.03. If the Patent Office must modify the combination further to show all the claim elements or the arrangement of the claim, the Patent Office must

show that there is a suggestion to modify the combination. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

If a claim element is missing after the combination is made, then the combination does not render obvious the claimed invention, and the claims are allowable. As stated by the Federal Circuit, “[if] the PTO fails to meet this burden, then the Appellant is entitled to the patent.” *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

**D. Claims 39 and 47 Are Definite under 35 U.S.C. § 112, Second Paragraph**

Claims 39 and 47 were rejected under 35 U.S.C. § 112, second paragraph for being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Specifically, the Patent Office asserts that “in reading the entirety of said Claims, a person of ordinary skill in the art would not be able to ascertain what makes said content ‘unique’ and ‘location specific’.”<sup>1</sup> The Patent Office supplements this statement with a series of hypothetical alternative situations where the content might be construed to be non-unique. As noted in the Response filed June 20, 2005, Appellant uses the term “unique” throughout the specification.

While Appellant appreciates that limitations of the specification are not imported into the claims, the definiteness and clarity of a term is not considered in a vacuum, but is considered in light of Appellant’s disclosure in the application. When someone of ordinary skill in the art reads Appellant’s disclosure, she sees several examples of what is intended by “unique content”, especially since that term is contrasted from the concept of “common content”. Still further explanation of the term “unique content” can be found in the specification, paragraph 0027, which fully addresses the concerns of the Patent Office about the differing host devices.

The example of citysearch.com in paragraph 0003 of the specification also provides a clear indication to someone of ordinary skill in the art what is intended by “unique content”. The citysearch.com example also helps address the Patent Office’s concerns about the location specific content. In short, while the Patent Office may feel that there are better terms that are more clear than the terms used in the claims, the language used in the pending claims does not make the claims so imprecise as to support a rejection under 35 U.S.C. § 112, second paragraph. As noted above, there is some latitude in the manner of expression and the aptness of the

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<sup>1</sup> Office Action of April 26, 2005, page 2, lines 16-17.

term, even though the claim language is not as precise as the examiner may desire. MPEP § 2173.02.

The Patent Office further “suggest that the wording of the claims may cause uncertainty regarding whether ‘location specific unique content’ is referring to the location of the mobile user or location of the host device”.<sup>2</sup> The preambles of the claims provide the context needed to understand the location at issue. Specifically, the preamble of claim 39 recites a “method for providing content to a mobile terminal user based on a location of a mobile terminal. . . .” This preamble makes it clear that the location specific unique content is referring to the location of the mobile user. The preamble of claim 47 is substantially identical, albeit as an apparatus claim rather than a method claim.

If the Patent Office is rejecting the claim based not on the clarity and precision requirement of 35 U.S.C. § 112, second paragraph, but on the subject matter that is regarded as the invention requirement, such an alternative rejection is not supported. Appellant notes that this requirement is a subjective requirement. Appellant’s first response, which included the new claims directed to the subject matter in question, does not indicate that Appellant regards something else as the invention. Appellant’s second response likewise argues that the currently claimed subject matter is the invention. Thus, there is no evidence in the record that Appellant believes something other than the currently pending claims to be the invention. Appellant requested that if the Patent Office disagreed, that the Patent Office should identify where in the record such an indication might exist. The Patent Office does not mention the § 112 rejection in the Advisory Action. In the absence of such an identification, there is no evidence in the record that a rejection under the second prong of 35 U.S.C. § 112, second paragraph is supported.

Thus, claims 39 and 47 satisfy both requirements of the second paragraph of 35 U.S.C. § 112. Appellant requests that the Board reverse the Examiner and instruct the Examiner to withdraw the § 112 rejection of claims 39 and 47.

**E. Claims 39-43, 46-51 and 54 Are Non-Obvious Over Owensby in View of Heddaya**

**1. The Patent Office Has Not Shown a Proper Motivation to Combine the References to Arrive at the Claimed Invention**

The Patent Office states that:

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<sup>2</sup> Office Action of April 25, 2005, page 3, lines 3-5.



...it would have been obvious to a person of ordinary skill in the art to implement the offloaded customization concepts as taught by Heddaya into the method and apparatus of Owensby, such that content may be customized and be made unique according to the location of the intermediate node. The suggested motivation for doing so would have been, as Heddaya suggests, to distribute the servicing of requests across multiple intermediate or secondary servers, such server being closer to the requesting user (by number of hops and distance), such that response time is faster and less network traffic is created. (See Heddaya, Column s 4 Lines 1-10)<sup>3</sup>

This motivation to combine Owensby and Heddaya does not create the advantage advanced by the Patent Office as part of the rationale to combine the references. There must be some suggestion to combine references in an obviousness rejection. *In re Dembiczak*. The Patent Office states that the motivation is to reduce response time and generate less network traffic. However, the Patent Office states that the use of Heddaya's intermediate servers results in "content that may be customized and be made unique according to the location of the intermediate node."<sup>4</sup> The ordinary combination of the references does not result in content that may be customized and made unique according to the location of the intermediate node because the references do not teach or suggest customization of this sort. The portion of Heddaya cited by the Patent Office that discusses customization are set forth in the margin for convenience.<sup>5</sup> While the passage indicates that the code executes and modifies the document to be sent to the client in a more customized form, and that the customization is done by the intermediate server, there is no indication that the customization is made unique according to the location of the intermediate server. Heddaya discusses customization in two other passages,<sup>6</sup> but neither location indicates that the customization is made unique according to the location of the node.

<sup>3</sup> Office Action of April 26, 2005, page 7, lines 3-11

<sup>4</sup> Office Action of April 26, 2005, page 7, lines 6-7.

<sup>5</sup> Heddaya, col. 3, lines 24-42 states in full:

Another approach involves offloading servicing work from a home server to an intermediate node interconnected between the home server and the client. Here, the home server sends a document and code to the intermediate node. At the intermediate node, the code executes and modifies the document. The modified document is then sent to the client in a more customized form. Accordingly, the work of customizing the document is performed by the intermediate node rather than the home server. An example of this approach is the use of Active Networks. One Active Network architecture is discussed in an article entitled "Towards an Active Network Architecture", by Tennenhouse et al., in a paper presented at a keynote session of Multimedia Computing and Networking, San Jose, Calif., January 1996, the teachings of which are incorporated by reference herein in their entirety. Another similar approach which is geared towards multimedia is explained in U.S. Pat. No. 5,592,626 (Papadimitriou et al.).

<sup>6</sup> See Heddaya, col. 5, line 42 and Heddaya, col. 12, line 41

To arrive at a system that customizes the content according to the location of the intermediate server, the combination of Owensby and Heddaya must be modified. The Patent Office has not provided the motivation and support to show that this modification to the combination is suggested. To summarize Appellant's previous arguments, the combination alone does not create the advantage set forth by the Patent Office as part of the reason for the combination. Since the combination does not, without inexplicable modification, provide the Patent Office's purpose for the combination, the motivation to combine the references is improper. Since the motivation to combine the references is improper, the combination is improper. Since the combination is improper, the Patent Office has not established *prima facie* obviousness, and the claims are allowable. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims on this basis.

As further evidence that the combination of references is non-obvious, the combination makes Heddaya unsuitable for its intended purpose. Assuming, *arguendo*, that content is customized according to the location of the intermediate node, this change in the content vitiates Heddaya's purpose of providing proxy intermediate nodes that spoof the client into believing that the proxy is the desired server. That is, Heddaya states that "as part of fulfilling service requests at the intermediate locations, the client nodes are sent appropriate messages, depending upon the communication protocol in use, to 'spoof' the client nodes into believing that the services were actually provided by the primary server node."<sup>7</sup> A particular example that becomes non-functional is the news server described by Heddaya.<sup>8</sup> Once the content diverges between the various nodes, the mobile agent of Heddaya no longer knows how to intercept messages and reroute requests to the closest server. By rendering Heddaya unsuitable for its intended purpose, the combination of references is non-obvious. Since the combination of references is non-obvious, the Patent Office has not established obviousness, and the claims are allowable.

For either of these reasons, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

## **2. The Combination Does Not Establish *Prima Facie* Obviousness**

Even if the combination of Owensby and Heddaya is proper, a point which Appellant

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<sup>7</sup> Heddaya, col. 4, lines 10-15.

<sup>8</sup> Heddaya, col. 10, line 48-col. 11, line 29.

does not concede, the combination does not teach or suggest all the claim elements as required to establish *prima facie* obviousness.

**a. “. . . establishing a plurality of unique internet protocol addresses from each of which unique content may be accessed . . .”**

In particular, independent claim 39 recites “establishing a plurality of unique internet protocol addresses from each of which unique content may be accessed. . . .”<sup>9</sup> The Patent Office does not specifically identify where this element is taught in the references, but the closest citation in the Office Action is Owensby, col. 11, lines 60-65, col. 22, lines 35-65, and col. 23, lines 1-25.<sup>10</sup> However, these passages do not teach or suggest the claim element.

Owensby, col. 11, lines 60-65 states in full: “. . . transceiver (not shown) for transmitting and receiving audio, video and/or electronic data in conjunction with conventional wireless communications services, such as wireless mobile telephony service, wireless mobile data transmission service and wireless mobile global computer network (e.g., Internet®) service. Most preferably, the wireless communications . . .” While the passage does indicate that a transceiver works with the internet, there is no indication that a plurality of unique internet protocol addresses are established from each of which unique content may be accessed, as recited in the claim. Merely because the passage uses the word “internet” does not mean that the passage teaches or suggests the recited establishing of a plurality of unique internet protocol addresses from each of which unique content may be accessed.

Owensby, col. 22, lines 35-65 states in full:

The Call Record Generator 29 also forwards the Ad Insert Records data to the Subscriber Support Module, indicated at 31 in FIG. 3. The Subscriber Support Module 31 processes inquiries, responses and requests from the subscriber. Immediately following completion of a targeted advertisement, a group of targeted advertisements or a call which included a targeted advertisement of particular interest to the subscriber, the Subscriber Support Module 31 can insert a related advertisement to provide additional information to the subscriber. The inquiry, response or request from the subscriber may be received and answered by a subscriber support representative or may be transmitted to the Subscriber Support Module 31 for processing by a keypad or voice command from the subscriber. The information provided to the subscriber may vary based on the geographical location of the subscriber at the time that the inquiry, response or request is made. Alternately, customer inquiries, responses and requests from the

<sup>9</sup> The other independent claim 47 recites essentially the same element allowing for differences between method and apparatus claims.

<sup>10</sup> Office Action of April 26, 2005, page 4, lines 2-5

subscriber may be addressed externally by a subscriber support representative using information provided to the representative by the Subscriber Support Module 31. The Subscriber Support Module 31 may also be programmed to forward the call to an external destination, such as a telemarketing representative. Additional information or forwarded calls may occur during the call immediately upon request, immediately after the call is completed or by a programmed call back. In addition, the Subscriber Support Module 31 may have the ability to provide information relating to the targeted advertisements previously provided to the subscriber. For example, when called by a subscriber, the Subscriber Support Module 31 may have the ability to provide the subscriber. . . .

The cited passage makes no reference to establishing internet protocol addresses from each of which unique content may be accessed. Rather, the passage references the advertisements that may be provided to the subscriber. There is, quite simply, no addressing scheme in this passage that could be equated to the recited element. As such, this passage does not teach or suggest the claim element.

Owensby, col. 23, lines 1-25 states in full:

. . . when each advertisement was inserted, the geographical location of the subscriber at the time the advertisement was inserted, the amount of the subsidy earned by the subscriber for the targeted advertisement, a contact number for the sponsor of the advertisement and any additional which the subscriber support representative can provide to the subscriber.

The Call Record Generator 29 may also be programmed to generate various reports for use by the operator of the service for subscriber billing and for progress and effectiveness review by the operator of the service or the sponsor of the advertisement. The Call Record Reports may list information such as the amount of subsidy earned by the subscriber, the geographical location for which an advertisement was inserted, the date and time at the location for which the advertisement was inserted, the order in which the advertisement was inserted in the call, an indication of whether the advertisement was fully inserted or partially inserted, the entire Subscriber Profile Data of the subscriber for whom the advertisement was inserted (possibly including address, name and home telephone number), whether the advertisement was a perfect match or involved a lower hierarchy match, the charge credit against the subscriber's account and the balance of the subscriber's account on the report date.

This passage, like the passage above, says nothing about any sort of addressing scheme or establishing a plurality of unique Internet protocol addresses from each of which unique content may be accessed. As such, the cited passage does not teach or suggest the claim element.

Quite simply, the Patent Office has not shown where in Owensby the claim element is shown. In the Advisory Action, the Patent Office asserts that Heddaya teaches internet protocol addressing for accessing unique content from cellular phones with a citation to Heddaya, col. 6, lines 15-20 and lines 45-50. This assertion is demonstrably false.

Heddaya, col. 6, lines 15-20 states in full "... home server 20. The network may make use of any and various types of physical layer signal transmission media such as public and private telephone wires, microwave links, cellular and wireless, satellite links, and other types of data transmission." Thus, while the passage discusses physical layer signal transmission media which may imply an internet protocol scheme there is no indication that this scheme is used to access unique content from cellular phones.

Heddaya, col. 6, lines 45-50 states in full "... network 10 is the Internet, that the service requested is access to information encoded in the form of the Hyper Text Transfer Protocol (HTTP) documents, and that document request messages are sent in the form of Uniform Resource Locators (URLs) using the TCP/IP layered protocol. This is with the understanding that other types of wired, switched . . ." Again, the passage does indicate that internet protocols can be used, but there is no indication that this is for accessing unique content from cellular phones, as is asserted by the Patent Office. In short, Appellant repeats its observation that merely because there is the mention of the term "internet" or "TCP/IP", there is not necessarily a teaching of establishing internet protocol addresses from each of which unique content may be accessed, as recited in the claims.

Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination of references does not teach or suggest the claim element, the combination does not establish obviousness. Appellant requests the Board reverse the Examiner and instruct the Examiner to allow the claims on this basis.

**b. "... associating each of the plurality of unique internet protocol addresses with different geographic locations . . ."**

Appellant further notes that the combination does not teach "... associating each of the plurality of unique internet protocol addresses with different geographic locations. . ." as recited in claim 39.<sup>11</sup> The Patent Office appears to rely on the same portions of Owensby<sup>12</sup> quoted

<sup>11</sup> Claim 47 has essentially the same element allowing for differences between method and apparatus claims.

above. Owensby, col. 11, lines 60-65 does indicate that a transceiver works with the internet, but there is no associating of unique addresses within the internet with different geographic locations. Thus, Owensby's first cited passage does not teach or suggest the claim element. Owensby, col. 22, lines 35-65 does state "information provided to the subscriber may vary based on the geographical location of the subscriber at the time that the inquiry, response or request is made."<sup>13</sup> However, there is no association of each of the unique internet protocol addresses with different geographic locations as recited in the claim. Merely because the passage states that information may vary based on the location of the subscriber does not mean that the passage teaches or suggests that internet protocol addresses are associated with different geographic locations. Indeed, there is no indication that the information of the passage is associated with any internet protocol address. Rather, the information is inserted into the call. The passage is silent as to the storage mechanism that contains the information, or how the information is accessed such that it is inserted into the call. Thus, this passage does not teach the recited claim element.

Owensby, col. 23, lines 1-25 also describes that the call record may track "the geographical location of the subscriber at the time the advertisement was inserted. . ."<sup>14</sup>, but the passage is again silent as to how the advertisement is located or tracked. Specifically, there is no teaching or suggestion in the passage that Internet protocol addresses are associated with different geographic locations, as recited in the claims.

Thus, the cited passages of Owensby do not teach or suggest the claim element. Likewise, the Patent Office has not identified anything in Heddaya that shows the claim element. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination cannot teach or suggest the claim element, the combination does not establish obviousness.

In the event that the Patent Office believes that the statement "while Owensby does not explicitly state providing internet protocol addresses it is obvious that in providing service provider contact information to the user, a form of internet addressing would be required in order to connect the user to the global computer network (the Internet service)"<sup>15</sup> is tantamount to the

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<sup>12</sup> Office Action of April 26, 2005, page 4.

<sup>13</sup> Owensby, col. 22, lines 48-52.

<sup>14</sup> Owensby, col. 23, lines 1-3 and 13-16.

<sup>15</sup> Office Action of April 26, 2005, page 4, lines 11-14

claim element, Appellant notes that this assertion is unsupported by any evidence. There is no evidence that teaches or suggests that Owensby teaches providing service provider contact information. While Owensby does allow the subscriber to establish a direct communication with a representative, there is no address provided to the subscriber.<sup>16</sup> Even if the ability to establish a connection to a representative implies some form of address is provided, Owensby does not associate this address with any sort of location. Thus, the Patent Office's assertion that the recited "associating each of the plurality of unique internet protocol addresses with different geographic locations" is obvious is incorrect.

If the Patent Office is implying that there is some possible modification to Owensby that would show the element, Appellant notes that the Patent Office has not complied with the instructions of *Fritch*. See also *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

In either event, it is not obvious that any address provided by Owensby is an internet protocol address, that such an address has unique content associated therewith, or that the address is associated with a different geographic location. Since Owensby does not teach any of these elements, and the Patent Office has not shown where these elements are taught in Heddaya, the combination of Owensby and Heddaya does not teach or suggest all the claim elements. Since the combination of Owensby and Heddaya does not teach or suggest all the claim elements, the Patent Office has not established obviousness, and the claims are allowable.

### 3. Claims 41 and 49 Are Separately Patentable

Claims 41 and 49 recite "allowing access to the content when the mobile terminal uses the identified address." The Patent Office asserts that Owensby, col. 8, lines 40-60 and col. 6, lines 1-25, teach this element. This assertion is demonstrably false. Owensby, col. 8, lines 40-60 states in full:

... Response Data in addition to the Wireless Mobile Location Data.

A preferred embodiment of a method according to the invention for providing a message to a subscriber of a wireless mobile communications service that is targeted to the subscriber on the basis of wireless mobile location includes at least the following steps. A first electronic database consisting of a plurality of pre-selected messages and predetermined criteria for choosing the messages to be provided to the subscriber is compiled. A wireless mobile terminal is then provided for initiating and receiving a wireless mobile communication comprising a call signal and Wireless Mobile Location Data included with the call signal. The call signal (if required) and the Wireless Mobile Location Data are then extracted

<sup>16</sup> Owensby, col. 10, lines 1-10.

from the wireless mobile communication and provided to a Call Management System including an Ad Chooser Server for choosing the messages to be provided to the subscriber. The predetermined criteria of the first database is then utilized to choose a message from the plurality of pre-selected messages of the first database that is targeted to the subscriber on the basis of the Wireless Mobile Location Data. Finally, the message that is targeted. . . .

While the passage describes the subscriber receiving messages/advertisements, there is no teaching or suggestion within the passage that the subscriber uses a received address to access content. In particular, Owensby's subscriber receives content without taking an affirmative step. Since the passage does not teach accessing content through the use of the identified address, as recited in the claim, the passage does not teach or suggest the element for which it is cited.

Owensby, col. 6, lines 1-25 states in full:

Further, the system and method of the invention permit the subscriber to interactively respond to a message provided to the subscriber, or to an inquiry for additional information from the operator of the service or from the sponsor of the message. Preferably, the operator queries the subscriber at the conclusion of a message, at the conclusion of a group of messages or at the conclusion of the wireless mobile communication, to select one of several options and then monitors the subscriber's response to the query. For example, the subscriber could request the operator to insert another message into the wireless mobile communication, to forward an audio, video or electronic data copy of the previously provided message to an electronic message input, storage and retrieval database (e.g., voice mail, e-mail, facsimile, etc.), or to establish a direct telecommunications or other data link with a representative of the sponsor of the message, such as a telemarketer. The subscriber may respond to the operator's query and the operator may fulfill the subscriber's request immediately following a particular message, immediately following a group of messages or following the conclusion of the wireless mobile communication (e.g., in the form of a "call-back" from a telemarketing representative).

While the passage indicates that the subscriber can request establishment of a direct telecommunications or other data link with a representative, this concept is not what is recited in the claims. Claims 41 and 49 recite accessing the content through the address. The passage teaches connecting to a representative after listening to an advertisement/message. These are not the same things. In the passage, the subscriber has already received the content and then gets supplemental information from the representative, but the subscriber never uses any address to access the content. The content has already been provided to the subscriber. As such, this passage does not teach or suggest the element for which it is cited.



Since the passages do not teach or suggest the element for which they are cited, Owensby does not teach or suggest the claim element. The Patent Office has thus failed to show where in the combination the element is taught or suggested. Since the Patent Office has failed to show where in the combination the element is taught or suggested, the Patent Office has not established obviousness, and claims 41 and 49 are allowable separately for reasons independent of the reasons for allowing the other claims.

#### **4. Claims 42 and 50 Are Separately Patentable**

Claims 42 and 50 recite "delivering the content to the mobile terminal in response to a request from the mobile terminal using the identified address." The Patent Office cites Owensby, col. 8, lines 40-60 and col. 6, lines 1-25. The cited passages are reproduced above. As explained above, the content is not delivered to the mobile terminal through the use of the identified address in the cited passages. In one passage, the subscriber is connected to a representative. That is not, as explained above, delivery of the content to the mobile terminal. The other passage does not show a request on the part of the subscriber to access the content through an address, either. The content is delivered independent of the subscriber's request. Even if the subscriber makes a request, such a request is independent of an address, and is merely a generic request for advertisements (so as to subsidize the phone call). Neither passage teaches the recited claim element.

Since the passages do not teach or suggest the element for which they are cited, Owensby does not teach or suggest the claim element. The Patent Office has thus failed to show where in the combination the claim element is taught or suggested. Since the Patent Office has failed to show where in the combination the claim element is taught or suggested, the Patent Office has not established obviousness, and claims 42 and 50 are allowable separately for reasons independent of the reasons for allowing the other claims.

#### **5. Claims 43 and 51 Are Separately Patentable**

Claims 43 and 51 recite "receiving a trigger initiated by an action of the mobile terminal as a condition of determining the current location of the mobile terminal." The Patent Office cites Owensby, col. 8, lines 40-60 and col. 6, lines 1-25. These passages are reproduced above. While the user can request more information by a request to be connected to the representative, this is not a condition for determining the current location of the mobile terminal. Nothing in the

cited passages represents a trigger that is a precondition to determining the current location of the mobile terminal, as recited in the claims.

Since the passages do not teach or suggest the element for which they are cited, Owensby does not teach or suggest the claim element. The Patent Office has thus failed to show where in the combination the claim element is taught or suggested. Since the Patent Office has failed to show where in the combination the claim element is taught or suggested, the Patent Office has not established obviousness, and claims 43 and 51 are allowable separately for reasons independent of the reasons for allowing the other claims.

**F. Claims 44, 45, 52, and 53 Are Non-Obvious Over Owensby in view of Heddaya, further in view of Guedalia**

Appellant notes that all the issues relating to the independent claims also apply to the rejection of claims 44, 45, 52, and 53. If the independent claims are determined to be allowable for any of the reasons set forth above, then these claims are likewise allowable.

Appellant further notes that these claims also have an independent reason why they are allowable. Specifically, the Patent Office has not properly supported the motivation to combine Guedalia with the required evidence. Specifically, the Patent Office asserts that it would be obvious to include Guedalia into the combined teachings of Owensby and Heddaya "for the benefit of superior marketing and advertising in order to arrive at the invention as described in claims 44-45 and 52-53."<sup>17</sup> This asserted motivation lacks the requisite evidentiary support required by the Federal Circuit. *In re Dembiczak*. Since the motivation lacks the requisite evidentiary support, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection based on the combination is improper, and the Patent Office has not established obviousness.

**G. Conclusion**

The Patent Office has not shown that the claims are indefinite. Likewise, the Patent Office has not satisfied the Federal Circuit's requirements relating to combining the references and thus the combinations of references are improper. Even if the combinations of references are proper, the combinations do not teach or suggest the claimed invention. For these reasons, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

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<sup>17</sup> Office Action of April 26, 2005, page 8, lines 7-9.

Respectfully submitted,

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**(8) CLAIMS APPENDIX**

39. A method for providing content to a mobile terminal user based on a location of a mobile terminal, comprising:

- establishing a plurality of unique internet protocol addresses from each of which unique content may be accessed, wherein said unique content is location specific;
- associating each of the plurality of unique internet protocol addresses with different geographic locations based on the location specific unique content;
- determining a current location of the mobile terminal;
- determining if content is available for the current location of the mobile terminal;
- identifying which of the plurality of unique internet protocol addresses corresponds to the current location of the mobile terminal;
- delivering the identified address to the mobile terminal such that the mobile terminal user may selectively access the content using the identified address.

40. The method of claim 39 wherein the identified address is delivered to the mobile terminal via one of the group consisting of: email, short message service, system signaling seven message, and web page.

41. The method of claim 39 further comprising allowing access to the content when the mobile terminal uses the identified address.

42. The method of claim 39 further comprising delivering the content to the mobile terminal in response to a request from the mobile terminal using the identified address.

43. The method of claim 39 further comprising receiving a trigger initiated by an action of the mobile terminal as a condition of determining the current location of the mobile terminal.

44. The method of claim 39 further comprising receiving a trigger unrelated to an action of the mobile terminal as a condition of determining the current location of the mobile terminal.

45. The method of claim 44 further comprising a service to generate the trigger.

46. The method of claim 39 further comprising providing a profile of a user of the mobile terminal, and screening the content associated with the plurality of unique internet protocol addresses based on the profile.

47. An apparatus for providing content to a mobile terminal user based on a location of a mobile terminal, comprising:

a network interface;

a control system associated with said network interface and adapted to:

establish a plurality of unique internet protocol addresses from each of which unique content may be accessed, wherein said unique content is location specific;

associate each of the plurality of unique internet protocol addresses with geographic locations based on the location specific unique content;

determine a current location of the mobile terminal;

determine if content is available for the current location of the mobile terminal;

identify which of the plurality of unique internet protocol addresses corresponds to the current location of the mobile terminal;

deliver the identified address to the mobile terminal such that the mobile terminal user may selectively access the content using the identified address.

48. The apparatus of claim 47 wherein the identified address is delivered to the mobile terminal via one of the group consisting of: email, short message service, system signaling seven message, and web page.

49. The apparatus of claim 47 wherein the control system is further adapted to allow access to the content when the mobile terminal uses the identified address.

50. The apparatus of claim 47 wherein the control system is further adapted to deliver the content to the mobile terminal in response to a request from the mobile terminal using the identified address.

51. The apparatus of claim 47 wherein the control system is further adapted to receive a trigger initiated by an action of the mobile terminal as a condition of determining the current location of the mobile terminal.
52. The apparatus of claim 47 wherein the control system is further adapted to receive a trigger unrelated to an action of the mobile terminal as a condition of determining the current location of the mobile terminal.
53. The apparatus of claim 52 further comprising a service provided computer to generate the trigger.
54. The apparatus of claim 47 wherein the control system is further adapted to provide a profile of a user of the mobile terminal, and screen the content associated with the plurality of unique internet protocol addresses based on the profile.

**(9) EVIDENCE APPENDIX**

Appellant relies on no evidence in the current appeal, so this appendix is not applicable.

**(10) RELATED PROCEEDINGS APPENDIX**

There are no related proceedings, so this appendix is not applicable.



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